In the Supreme Court of the United States

OCTOBER TERM, 1972

No. 72-1185

MURRAY FIELDS AND CONSOLIDATED FOODS CORPORATION, PETITIONERS

v.

WILLIAM E. SCHUYLER, JR., Commissioner of Patents

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

MEMORANDUM FOR THE RESPONDENT

The petition raises the question of the proper test for determining whether a design patent meets the statutory requirement for patentability stated in 35 U.S.C. 103.

1. Petitioners' application to the Patent Office sought a design patent for the ornamental design of a ballpoint pen (Pet. App. 14a). The Patent Examiner denied the application, finding that in comparison to previously-granted design patents (Pet. App. 15a, 17a), the claimed design exhibited only "obvious modifications to a person of ordinary skill working in this field and therefore [is] unpatentable under the provisions of 35 U.S.C. 103" (Pet. App. 11a). The Patent Office Board of Appeals affirmed (Pet. App. 10a).

The district court affirmed the decision of the Patent Office, holding that (Pet. App. 6a):

> Title 35 U.S.C. 103 denies patentability to a novel design if the differences between the design and the prior art are such that the design would have been obvious to one skilled in the art.

Upon appeal, petitioners contended that the Patent Office and the district court had erroneously framed the test of patentability as "obvious to one skilled in the art." Petitioners asserted that although the statute refers to "one skilled in the art," the proper test for patentability of designs—in contrast to other kinds of patents—is whether the design would be "obvious to the 'ordinary intelligent man'" (Pet. App. 3a). In rejecting this argument, the court of appeals concluded that "the statute calls for application as written"; "while Congress has provided for limited monopoly as a means of enhancement of the industrial arts, it never intended to give such a monopoly to a person whose contribution could fairly be regarded as one that was obvious to a person of 'ordinary skill' in the pertinent art" (Pet. App. 5a). The court stated (Pet. App. 3a-4a):

> In short, while the judge must rely on his own visual impression as to whether the claim design is novel in the sense of conveying an aesthetic effect substantially different from that previously seen in the art, there is also a more objective reference point when he comes to consider whether the new design "reflected originality born of inventive faculty" [footnote omitted], or was obvious to one skilled in the art.

2. The decision of the court of appeals is correct. However, in view of the conflict among the circuits,[1] which the court of appeals acknowledged (Pet. App. 3a), on this significant question of patent law, the Commissioner of Patents agrees that the petition for a writ of certiorari should be granted.

Respectfully submitted.

ERWIN N. GRISWOLD,
Solicitor General.

APRIL 1973.

---

[1] The decision of the court of appeals conflicts with the decisions of the Court of Customs and Patent Appeals in *Application of Laverne*, 356 F. 2d 1003, 1006 and *Application of Schulling*, 421 F. 2d 747, and with the Ninth Circuit's decision in *Schwinn Bicycle Co.* v. *Goodyear Tire & Rubber Co.*, 444 F. 2d 295, 299. The conflict between the Court of Customs and Patent Appeals and the Court of Appeals for the District of Columbia Circuit is particularly important because the two courts have concurrent jurisdiction to review decision of the Patent Office. 35 U.S.C. 141 and 145. The other courts of appeals determine the validity of design patents when considering the affirmative defense of patent invalidity in an infringement suit, 35 U.S.C. 281, 282(2).

The decision below accords with *International Silver Co.* v. *Pomerantz*, 271 F. 2d 69, 71 (C.A. 2); *HADCO Products, Inc.* v. *Walter Kidde & Co.*, 462 F. 2d 1265, 1271, 1272 (C.A. 3); *Blumcraft of Pittsburgh* v. *Citizens and Southern Nat. Bank*, 407 F. 2d 557, 559 (C.A. 4).

DOJ 1973 04